

Application No.: 10/767,744Docket No.: 713-1004**REMARKS**

The Examiner's indication of allowable subject matter of claim 19 is noted with appreciation.

Claims 19-38 are pending in the application. Claims 1-18 have been cancelled without prejudice or disclaimer. Allowable claim 19 has been rewritten in independent form to include limitations of base claim 1 and intervening claim 18. Claims 19 and 20 have further been amended to improve claim language. New claims 21-38 have been added to provide Applicants with the scope of protection to which they are believed entitled. The specification and Abstract have been revised to conform with commonly accepted US patent practice. No new matter has been introduced through the foregoing amendments.

The objection to the specification is moot as the claim limitation "duct" is no longer recited in the claims.

The objection to claims 10-12 is also moot as these claims have been cancelled.

The rejection of claims 1-20 under the judicially created doctrine of the obviousness-type double patenting over claims 1-2 and 7 of commonly owned, copending application Serial No. 10/767,745 is noted. This rejection is obviated through the submission of the attached Terminal Disclaimer. It should be noted that the filing of the attached Terminal Disclaimer is not an admission of the propriety of the Examiner's rejection.

The *35 U.S.C. 112, second paragraph* rejection of claims 7-8, 11-12, and 15 is moot as the rejected claims have been cancelled. Amended claims 19-20 and new claims 21-38 are believed free of any indefiniteness issues within the meaning of *35 U.S.C. 112, second paragraph*.

The art rejections primarily relying on *Miura* (U.S. Patent No. 6,708,931) are either moot or overcome in view of the foregoing amendments. In particular, amended claim 19 includes the

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allowable subject matter indicated in the Office Action and should be allowed. Amended claim 20 now depends from claim 19 and should also be allowed.

New independent claim 21 is patentable over the applied references, especially *Miura*, because the references fail to disclose, teach or suggest the claimed one-piece retaining member for holding and supporting an elongated element from a support, said one-piece retaining member comprising: a holding portion being attachable to the support and comprising a recess for holding the elongated element therein, said holding portion having an underside adapted to face the support when said holding portion is attached to the support; and a resilient contact portion disposed on the underside of said holding portion to define a lowermost portion of said retaining member, said resilient contact portion being adapted to be placed between said holding portion and the support and to bear against the support when said holding portion is attached to the support, thereby minimizing vibration transmission from said holding portion to the support. New claim 21 finds solid support in the original specification, e.g., at page 7, lines 10-11, and the original drawings, e.g., FIGs. 1-2.

*Miura* fails to teach or disclose the invention of new claim 21, because the reference discloses a multiple piece structure. As best seen in FIG. 1 of *Miura*, clamp C includes two separable parts, i.e., a clip body 1 and a clamp body 21. *See also* column 3, lines 26-28 of *Miura*.

*Miura*, singly or in combination with other cited references, fails to render claim 21 obvious, because the *Miura* reference teaches away from the claimed invention. *See MPEP*, section 2145 (It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)).

The object of the *Miura* technical solution is to provide a clamp for tubular elements wherein the clamp can be easily adapted to various diameters of the tubular elements by replacing only a clamp's part, i.e., the clamp main body, rather than the whole clamp. *See column 1, lines 42-*

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45 of *Miura*. The reference specifically requires that the clamp comprise two separate elements, i.e., clip body 1 and clamp body 21, so that clamp body 21 of an appropriate size can be selected. See the "Summary of the Invention" section at column 2, lines 4-5 of *Miura*. This is also evident from the entire specification, including all drawings, of the *Miura* reference. Note, especially column 7, lines 35-45 where *Miura* discusses the advantage of having a multiple piece structure. Thus, the reference explicitly teaches away from making the clamp integrated.

In a number of occasions, e.g., at column 7, lines 24-30, *Miura* mentions the possibility of making certain parts of his device, e.g., shock-absorbing portion 10 and attaching part 2, integrated. This indicates that *Miura* must also have considered the possibility of making other parts, e.g., clip body 1 and clamp body 21, integrated. However, the fact that the reference is completely silent on the possibility of integrating clip body 1 and clamp body 21 indicates that *Miura* has excluded this possibility from the scope of his invention. In other words, by failure to mention the possibility of making the entire clamp integrated, *Miura* implicitly teaches away from the claimed one-piece structure.

Accordingly, Applicants respectfully submit that *Miura* fails to teach or disclose the invention of claim 21 and cannot be properly modified to arrive at the claimed invention. Therefore, new independent claim 21 is patentable over *Miura*. Claim 21 is also patentable over the other cited references, as will be apparent to the Examiner upon reviewing the references.

Claims 22-37 depend from claim 21, and are considered patentable at least for the reasons advanced with respect to claim 21. Claims 22-37 are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art.

For example, as to claims 23-24, the applied references, especially *Miura*, clearly fail to teach or suggest that the arm extends laterally away from said base portion and **obliquely**

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**upwardly away from said resilient contact portion**, whereby the recess and the elongated element held therein can be placed further from the support than said base portion, avoiding undesired contact and vibration transmission between the elongated element and the support. See claim 23. Claims 23-24 are supported at least by original claim 8. In *Miura*, e.g., FIG. 29, arm 27 does not extend obliquely upwardly as presently claimed.

As to claim 27, the applied references, especially *Miura*, clearly fail to teach or suggest the claimed resilient contact element having a **convex** lower surface extending from a lowermost point upwardly in opposite directions towards said arms. The legs 11a-b of *Miura* have flat lower surfaces as can be seen in FIGs. 11-13 of *Miura*.

As to claims 28-29, the applied references, especially *Miura*, clearly fail to teach or suggest the claimed peripheral **downwardly extending** wall positioned **between** said resilient contact elements, and wherein a height of said peripheral wall as measured from lower surfaces of said arms is smaller than that of said resilient contact elements, whereby said peripheral wall may contact, in use, the support only after sufficient compression of said resilient contact elements. See claim 28. Element 28b (FIG. 30) of *Miura* is not a downwardly extending wall. The unnumbered, outermost element immediately above 11b in FIG. 30 is not positioned between the legs 11b.

As to claim 31, the applied references, especially *Miura*, clearly fail to teach or suggest the claimed resilient contact portion that has a **lower surface** which is adapted to contact the support and **curved downwardly**, away from said holding portion. The legs 11a-b of *Miura* have **flat** lower surfaces as can be seen in FIGs. 11-13 of *Miura*.

As to claim 32, the applied references, especially *Miura*, clearly fail to teach or suggest the claimed feature that said holding portion and said resilient contact portion are made of the **same** plastic material, said resilient contact portion comprising a non-rigid feature which gives said resilient contact portion a spring constant lower than that of said holding portion. *Miura* discloses

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different materials for legs 11a-b and clamp body 21. *See* column 3, lines 36-41 of *Miura*.

As to claim 33, the applied references, especially *Miura*, clearly fail to teach or suggest the claimed feature that said holding portion is made of a harder material and said resilient contact portion is made of a softer material, **said harder and softer material being integrally molded into a single body of said one-piece retaining member**. As discussed above, *Miura* requires the device to include two pieces as best seen in FIG. 1 of the reference.

As to claim 34, the applied references, especially *Miura*, clearly fail to teach or suggest the claimed feature that said recess includes a **resilient lining connected with said resilient contact portion** by a connecting element made of the material of said lining. The highlighted limitation is similar to the limitation of allowable claim 19 which has been held to be free of prior art by the Examiner. Likewise, claims 35-38 are patentable over the applied references.

Each of the Examiner's rejections has been traversed/overcome. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

**LOWE HAUPTMAN & BERNER, LLP**



James J. Bindseil  
Registration No. 42,396

for: Benjamin J. Hauptman  
Registration No. 29,310

*USPTO Customer No. 22429*  
1700 Diagonal Road, Suite 310  
Alexandria, VA 22314  
(703) 684-1111 BJH/KL/kb  
(703) 518-5499 Facsimile  
Date: March 17, 2005

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